



PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 58268.00157
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 09/580,665	Filed: May 26, 2000
	First Named Inventor:	
	Ian Crayford	
	Art Unit: 2155	
		Examiner: Bharat Barot

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed
- ☒ Attorney or agent of record.
Registration No. 58,178
- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


Signature

Peter Flanagan
Typed or printed name

703-720-7864
Telephone number

November 8, 2006
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No. 8203

Ian CRAYFORD et al.

Art Unit: 2155

Application No.: 09/580,665

Examiner: Bharat Barot

Filed: May 26, 2000

Attorney Dkt. No.: 58268.00157

For: METHOD AND APPARATUS FOR NETWORK HUB TO DIAGNOSE NETWORK
OPERATION AND BROADCAST INFORMATION TO A REMOTE HOST OR
MONITORING DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 8, 2006

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-42 in the above identified application. Claims 1-42 were finally rejected in the Office Action dated August 8, 2006 ("the Office Action"). Applicants filed a Response to the Final Office Action on September 12, 2006 ("the Response"), and the Office issued an Advisory Action dated September 25, 2006 ("the Advisory Action"), maintaining the final rejections of claims 1-42. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Clear Error: The Rejection Denies Applicants' Lexicographic Right

Claims 1-14 and 21-42 were rejected under 35 U.S.C. 103(a) as unpatentable over Kristol in view of Barrett. The Office Action took the position that Kristol teaches all the elements of the claim except "the server configured to push status information to a client without a request for the status information from the client, wherein the status information includes network information." The Office Action cited Barrett as allegedly curing this deficiency in Kristol. Applicants respectfully submit that this rejection includes clear error and should be reversed.

Kristol is directed to a method of multicasting. Kristol generally discusses a method in which Source S sends a multi-cast packet to all destinations. Each destination that is first in the

column sends its status to S, and each other destination in the column sends its destination to the first destination in the column. The first destination in the column ($E_{i,1}$) locally remulticasts if $E_{i,1}$ receives the multicast packet but a destination below it ($E_{i,j}, j \neq 1$) has not, and S remulticasts if a first destination in a column has not received the packet.

Barrett relates to user-centered push methods and systems. Barrett uses language like “pushing network information.” The way that Barrett defines “pushing network information” is, operationally, obtaining information from cyberspace, as illustrated in column 1, lines 20-27. In particular, Barrett’s “pushing network information” is defined operationally by commercial software applications like The Pointcast Network TM, Castanet Tuner TM, Netcaster TM, and Microsoft’s CDF channels. Accordingly, “pushing network information” as used by Barrett relates to pushing information on a network, as opposed to pushing information about a network.

Claim 1 recites the limitation “the server is configured to push status information to a client without a request for the status information from the client, wherein the status information includes network information.” The Office Action correctly noted that Kristol does not teach or suggest this limitation.

Barrett does not remedy the deficiencies of Kristol. Barrett also does not teach or suggest this limitation, for at least the following three reasons:

1. Barrett deals with pushing information contained in a network, not “network information” as claimed.
2. Barrett does not teach pushing information relating to the “status” of a network, it only discusses pushing information that may be of interest to a user based on a dynamic model that permits changing interest on the part of the user.
3. Barrett does not indicate that Barrett’s server is a network hub in a communication network, and such a configuration is not implied by Barrett’s design.

The Office Action, at page 8, item 22(A), responded to Applicants’ argument that Barrett does not disclose or suggest that the network information is information about a network, by asserting that it does, and citing the abstract; Figure 1; column 1, lines 5-11, 28-35, and 59-65; column 2, lines 55-67; and column 5, line 41 to column 6, line 47 of Barrett. However, as set forth in detail at pages 5-7 of the Response, each of these passages is either completely devoid of any relevant description or supports Applicants’ argument.

Applicants respectfully submit that the Office Action’s interpretation of Barrett’s network information as information **about** a network is not a fair or reasonable reading of Barrett. Barrett

is essentially interested in pushing, to a user, headlines for news stories of interest to that user. Reading Barrett as teaching that its network information is “information about a network” constitutes either clear factual error in analyzing Barrett or clear legal error in denying Applicants’ right to define the claim recitations.

Clear Error: Applicants’ Analysis Unrebutted but Rejection Maintained

A response filed May 17, 2006, (“the Previous Response”) analyzed the cited passages in detail at pages 6-7 thereof, and the Response analyzed the cited passages as well, as noted above. The Office Action provided no response to the detailed analysis in the Previous Response, nor did the Advisory Action provide a response to the detailed analysis in both the Previous Response and the Response, although MPEP 707.07(f) obligates the Examiner to answer all material traversed. In the absence of a stated reason for rejecting Applicants’ analysis, there is no rational basis for upholding the rejection, and the Office Actions’ failure to rebut Applicants’ position while still maintaining the rejection constitutes clear legal error.

Clear Error: The Rejection Fails to Address All of the Elements of the Claim

Applicants have shown that Barrett does not disclose that the server is a network hub. The Previous Office Action had responded that it would have been obvious to apply the teaching of Barrett to a network hub of Kristol, because it would have “improved control through the information is easily reformatted locally and improved transmission efficiency through pushed without a request and archived for later use.”

The Office Action and Advisory Action took the position that the term “network hub” is not given patentable weight because it appears in the preamble. However, the Federal Circuit has held “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). *See also* MPEP 2111.02. In the context of the claims, “network hub” is a limitation of the claim, because among other things the term is needed to provide antecedent support for the further limitations recited in claims 6-8. Additionally, the term “network hub” recites structure, not intended purpose, and thus the Office Action’s use of form paragraph 7.37.10 is mistaken. Accordingly, it is clear legal error for the Office Action to refuse to accord “network hub” patentable weight.

Clear Error: The Proposed Combination/Modification is Infeasible and thus Non-Obvious

The Office Action's proposed combination is infeasible. There is no evidence that one of ordinary skill in the art would have been able to incorporate Barrett's server into a network hub. Indeed, such an implementation would have been counterintuitive, because it would not provide any benefit, and because it would decrease the modularity both of the network hub and Barrett's server.

The Office Action's combination of references, thus, is impermissible hindsight reconstruction, as described in MPEP 2145. The Office Action does not provide proper motivation to combine the teachings of the references, and accordingly fails to provide a *prima facie* case for obviousness. As MPEP Section 2143.01 indicates, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the present rejection, there is not even evidence that Barrett's server could be implemented as or on a network hub, much less that such a modification would be desirable. Accordingly, it is respectfully requested that this rejection be withdrawn.

Additionally, as previously noted, there is further flaw in the Office Action's assertion that Barrett's server could be implemented on the network hub of Kristol. The word "hub" does not appear in Kristol, and Kristol presents a method of multicasting which is designed to be carried out at "a source host," not a network hub, as explained by Kristol at column 2, lines 23-29. Accordingly, the combination of Kristol and Barrett do not teach or suggest the claimed "network hub." Thus, the proposed combination of Kristol and Barrett is infeasible and therefore non-obvious.

Furthermore, one of ordinary skill in the art would not have combined Kristol and Barrett. Kristol and Barrett take diametrically opposing approaches to communicating information. Those diametrically opposing approaches are set forth in detail in the first full paragraph of page 16 of the Response. As explained there, the asserted combination of Kristol and Barrett would change the principle of operation of Kristol, or render Kristol inoperable for its intended purpose. See MPEP 2143.01. Therefore, it is clear error for the Office Action to combine Kristol and Barrett.

Clear Error: Inoperability of Proposed Combination Unrebutted but Rejection Maintained

The Office Action and Advisory Action did not address the inoperability argument as presented in the Response and Previous Response. Thus, it is unrebutted in the record that the

combination of Kristol with Barrett would render Kristol inoperable for its intended purpose. As such, there is no rational basis upon which the rejection can be upheld.

The Office Action took the position at page 9, item 22(B), that the combination would have "improved control through [sic] the information is easily reformatted locally and improved efficiency through [sic] pushed without a request and archived for later use." However, such an improvement would still not provide motivation to combine the references because, as noted above, the trade-off would be to render the primary reference, Kristol, inoperable for its intended purpose. Moreover, the Office Action did not provide evidence or reasoned analysis for this alleged motivation.

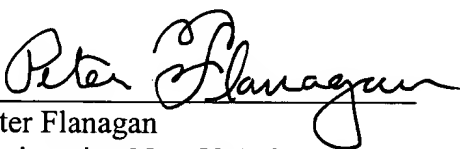
Same or Similar Clear Errors Apply to Rejections of other claims.

Although claims 21, 31, and 42 each have their own scope and their own particular recitations, the clear errors noted above with regard to claim 1 also are applicable to the rejections of claims 21, 31, and 42, as well as to dependent claims 2-14, 22-30, and 32-41.

Claims 15-20 were rejected under 35 U.S.C. 103(a) as obvious over Kristol and Barrett in view of U.S. Patent No. 5,651,006 of Fujino et al. ("Fujino"). Claims 15-20 depend from independent claim 1. Thus the clear errors with regard to claim 1 apply with equal or greater force to this rejection. Fujino does not cure any of these errors.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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Enclosures: PTO/SB/33 Form; Notice of Appeal; Check No. 15363